

## B. REMARKS

In this reply, Claims 1, 19 and 26-28 have been amended. Hence, Claims 1-76 are pending in this application. The amendments to the claims do not add any new matter to this application. Furthermore, the amendments to the claims were made to improve the readability and clarity of the claims and not for any reason related to patentability. All issues raised in the Final Office Action mailed on September 17, 2004 and the Advisory Action mailed on November 24, 2004 are addressed hereinafter.

### **REJECTION OF CLAIMS 1-12, 14-39, 41-56 AND 58-76 UNDER 35 U.S.C. § 102(e)**

In the Final Office Action, Claims 1-12, 14-39, 41-56 and 58-76 were rejected under 35 U.S.C. § 102(e) as being anticipated by *Blumberg et al.*, U.S. Patent Application Publication No. US 2003/0140315 A1 (hereinafter “*Blumberg*”). It is respectfully submitted that Claims 1-12, 14-39, 41-56 and 58-76, as amended, are patentable over *Blumberg* for at least the reasons provided hereinafter.

### **CLAIM 1**

Claim 1, as amended, recites a method for previewing an electronic document that requires:

“generating the electronic document at a client;  
transmitting document information associated with the electronic document from the  
client to a printing device having a print process for generating hard-copy  
printouts of electronic documents at the printing device;  
the printing device generating preview document data based on the document information  
and a set of one or more specific characteristics associated with the printing  
device, wherein the set of one or more specific characteristics are unavailable at  
the client;  
the printing device transmitting the preview document data to the client; and  
previewing the electronic document at the client based on the preview document data  
received from the printing device.”

It is respectfully submitted that Claim 1 includes one or more limitations that are not taught or suggested by *Blumberg*. For example, Claim 1 requires that the printing device have “a print process for generating hard-copy printouts of electronic documents at the printing device” and that the printing device generate “preview document data based on the document information and a set of one or more specific characteristics associated with the printing device, wherein the set of one or more specific characteristics are unavailable at the client.” It is respectfully submitted that *Blumberg* does not teach or suggest a method for previewing an electronic document that includes a printing device with these limitations.

It is respectfully submitted that there is no description or suggestion in *Blumberg* that the on-demand printing server 210 includes “a print process for generating hard-copy printouts of electronic documents,” as recited in Claim 1. On-demand print server 210 is described in *Blumberg* in the context of a classic conventional server for managing documents, without any printing capabilities or any “print process for generating hard-copy printouts of electronic documents,” as recited in Claim 1. All printing is described in *Blumberg* as being handled by other entities, such as local printer 260, or printers available at corporate reproduction center 280. It is therefore respectfully submitted that the method for previewing an electronic document that includes the use of a printing device having a print process, as recited in amended Claim 1, is not taught or suggested by *Blumberg* and that Claim 1 is therefore patentable over *Blumberg*.

#### CLAIMS 2-12 AND 14-18

Claims 2-12 and 14-18 all depend from Claim 1 and include all of the limitations of Claim 1. It is therefore respectfully submitted that Claims 2-12 and 14-18 are patentable over *Blumberg* for at least the reasons set forth herein with respect to Claim 1. Furthermore, it is

respectfully submitted that Claims 2-12 and 14-18 recite additional limitations that independently render them patentable over *Blumberg*.

#### CLAIM 19

Claim 19, as amended, recites “the printing device includes a print process for generating hard-copy printouts of electronic documents at the printing device.” Claim 19 also recites that the printing device with the print process generates the preview document data “based on the document information and a set of one or more specific characteristics associated with the printing device.” As set forth herein with respect to Claim 1, there is no mention or suggestion that the on-demand printing server 210 described in *Blumberg* includes a print process or generates the preview document data, as recited in Claim 19. It is therefore respectfully submitted that Claim 19 includes one or more limitations that are not in any way taught or suggested by *Blumberg* and is therefore patentable over *Blumberg*.

#### CLAIMS 20-25

Claims 20-25 all depend from Claim 19 and include all of the limitations of Claim 19. It is therefore respectfully submitted that Claims 20-25 are patentable over *Blumberg* for at least the reasons set forth herein with respect to Claim 19.

#### CLAIMS 26-28

Claims 26-28 recite limitations similar to Claim 1, except in the context of a computer-readable medium, a system and a document preview apparatus. It is therefore respectfully submitted that Claims 26-28 are patentable over *Blumberg* for at least the reasons set forth herein with respect to Claim 1.

#### **CLAIMS 29-39 AND 41-45**

Claims 29-39 and 41-45 all depend from Claim 26 and include all of the limitations of Claim 26. It is therefore respectfully submitted that Claims 29-39 and 41-45 are patentable over *Blumberg* for at least the reasons set forth herein with respect to Claim 26.

#### **CLAIMS 46-56 AND 58-62**

Claims 46-56 and 58-62 all depend from Claim 27 and include all of the limitations of Claim 27. It is therefore respectfully submitted that Claims 46-56 and 58-62 are patentable over *Blumberg* for at least the reasons set forth herein with respect to Claim 27.

#### **CLAIMS 63-69**

Claims 63-69 recite limitations similar to Claims 19-25, except in the context of computer-readable media. It is therefore respectfully submitted that Claims 63-69 are patentable over *Blumberg* for at least the reasons set forth herein with respect to Claims 19-25.

#### **CLAIMS 70-76**

Claims 70-76 recite limitations similar to Claims 19-25, except in the context of apparatuses. It is therefore respectfully submitted that Claims 70-76 are patentable over *Blumberg* for at least the reasons set forth herein with respect to Claims 19-25.

In view of the foregoing, it is respectfully submitted that Claims 1-12, 14-39, 41-56 and 58-76 are patentable over *Blumberg*.

**REJECTION OF CLAIMS 13, 40 AND 57 UNDER 35 U.S.C. § 103(a)**

Claims 13, 40 and 57 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Blumberg* in view of *Bando*, U.S. Patent No. 6,449,053. It is respectfully submitted that Claims 13, 40 and 57 are patentable over *Blumberg* and *Bando*, alone or in combination, for at least the reasons provided hereinafter.

Claim 13 depends from Claim 1 and includes all of the limitations of Claim 1. As previously set forth herein, Claim 1 includes one or more limitations that are not taught or suggested by *Blumberg*. These limitations are also recited in Claim 13. In the Advisory Action, the Examiner noted that *Bando* is not relied upon for teaching the Claim 1 limitation of generating preview document data at the printing device. Applicant agrees that *Bando* does not teach or suggest this limitation. Accordingly, given the arguments provided herein that Claim 1, as amended, recites one or more limitations not taught or suggested by *Blumberg*, it is respectfully submitted that Claim 13 also includes one or more limitations not taught or suggested by *Blumberg* or *Bando*, considered alone or in combination, and that Claim 13 is therefore patentable over *Blumberg* and *Bando*.

Claims 40 and 57 recite limitations similar to Claim 13, except in the context of a computer-readable medium and an apparatus, respectively. It is therefore respectfully submitted that Claims 40 and 57 are patentable over *Blumberg* and *Bando* for at least the reasons set forth herein with respect to Claim 13.

It is respectfully submitted that all of the pending claims are in condition for allowance and the issuance of a notice of allowance is respectfully requested. If there are any additional charges, please charge them to Deposit Account No. 50-1302.

The Examiner is invited to contact the undersigned by telephone if the Examiner believes that such contact would be helpful in furthering the prosecution of this application.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP



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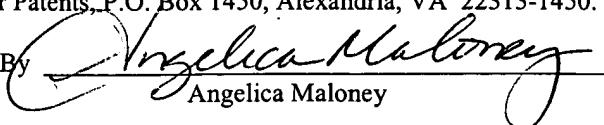
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: **Mail Stop RCE**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

On January 18, 2005 By



Angelica Maloney